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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,248	11/25/2003	Yves P. Arramon	PX-15	6049

21394 7590 04/30/2008

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EXAMINER	
CUMBERLEDGE, JERRY L	
ART UNIT	PAPER NUMBER
3733	

NOTIFICATION DATE	DELIVERY MODE
04/30/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel_prop@arthrocare.com

Office Action Summary	Application No.	Applicant(s)	
	10/723,248	ARRAMON, YVES P.	
	Examiner	Art Unit	
	JERRY CUMBERLEDGE	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 January 2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *01/17/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The affidavit filed on 08/06/2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Mazzuca reference.

With regard to Applicant's arguments directed to the affidavit, it is noted that the showing of facts must be such, in character and weight, as to establish that due diligence occurred prior to the effective date of the reference and up to the date of constructive reduction to practice (*i.e.* filing of the application)(MPEP 715). There is no evidence of record which indicates that due diligence occurred *prior* to the effective filing date of the reference. Applicant's remarks directed to the time window of approximately two months between the effective filing date of the Mazzuca reference and the filing of the present Application do not factually support that due diligence occurred prior to the effective date of the Mazzuca reference.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25, 26, 32 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Mazzuca et al. (US Pub. 2005/0070915 A1).

Mazzuca et al. disclose an implant material injection system adapted for performing a percutaneous vertebroplasty procedure comprising: a remote actuator (Fig. 2, ref. 40); a pump (Fig. 2, ref. 100) comprising a piston (Fig. 2, ref. 66) and a drive chamber (Fig. 2, ref. 60), the pump having a distal end (Fig. 2, end near ref. 64) adapted to connect with a cannula (Fig. 2, ref. 30), the drive chamber adapted to hold implant material (paragraph 0054, lines 1-3) (paragraph 0056, lines 10-12), the piston adapted to drive the implant material through the distal end of the drive chamber to an implant site (paragraph 0057); a control line (Fig. 4, ref. 15) connecting the remote actuator and the pump (Fig. 4), the control line adapted to advance the piston (paragraph 0053, lines 7-9); and wherein the implant material comprises a flowable hard tissue implant material (paragraph 0054). The control line comprises a fluid column adapted to advance the piston (column 0053). The system further comprises a cannula (Fig. 2, ref. 30) removably connected with the distal end of the drive chamber. The implant material comprises polymethylmethacrylate (paragraph 0054).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzuca et al. (US Pub. 2005/0070915 A1).

With regard to claims 27, 28 and 30, Mazzuca et al. disclose the claimed invention except for the control line has a length of about one foot; the control line has a length of about 36 inches; the control line has a length of about 48 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the control line of Mazzuca et al. at a length of about one foot/ of about 36 inches/ of about 48 inches, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

With regard to claims 29 and 31, Mazzuca et al. disclose the claimed invention except for the control line having a length of at least 36 inches; the control line having a length greater than 48 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the control line having a length of at least 36 inches/ the control line having a length greater than 48 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzuca et al. (US Pub. 2005/0070915 A1) in view of Bischof et al. (US Pat. 4,915,688) further in view of Lautenschlager et al. (US Pat. 5,902,839).

Mazzuca et al. disclose the claimed invention except for the system further comprising an implant material reservoir connected with the pump, the pump adapted to draw implant material from the material reservoir into the drive chamber.

Bischof et al. disclose a device comprising implant material reservoirs (Fig. 1, refs. 20 and 21) connected to a pump (column 3, lines 58-64), the pump being adapted to draw implant material from the material reservoir into the drive chamber (column 3, lines 58-64), the reservoirs being useful for holding supplies of different components and keeping them separate from the other components of a predetermined mixture (column 2, lines 54-57) until the time that they are required to be mixed and administered to a patient (column 2, lines 24-31).

Lautenschlager et al. disclose a bone cement (*i.e.* an implant material) that comprises at least two liquid components (column 2, lines 21-24), which can be held in separate containers in a single cement delivery device (column 3, lines 15-17) and mixed just prior to being delivered to the patient (column 2, lines 21, 24), the two separate liquid components being used in a delivery device having two separate storage components, in order to keep the components separate until they are required to be mixed (column 3, lines 15-19) after which they will harden (column 7, lines 24-26). An advantage of this system is that it introduces less air into the bone cement as it is being mixed (column 3, lines 15-23).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have constructed the device of Mazzuca et al., which is used to deliver implant material (Mazzuca et al., paragraph 0054), with the implant material

reservoirs of Bischof et al., in order to hold a bone cement (i.e. implant material) of Lautenschlager et al. The implant material reservoirs of Bischof et al. would provide the device of Mazzuca et al. with at least two separate containers to hold the separate components of the bone cement of Lautenschlager et al. This set-up would be advantageous because it would allow for less air to be introduced into the bone cement while it is being mixed (Lautenschlager, column 3, lines 15-23).

With regard to statements of intended use and other functional statements (e.g. "...are adapted to draw implant material..." and "...adapted to drive said piston..." and movement corresponds to 1 to 1 with movement..."), they do not impose any structural limitations on the claims distinguishable over the device of Bischof et al. in view of Kline, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JERRY CUMBERLEDGE whose telephone number is (571)272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. C./

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733